## REMARKS

The title has been amended to more specifically identify subject matter claimed in the present application. No new matter is added by way of the amendments to the title.

Claim 1 has been amended to recite a process to isolate a neurotrophin from a mixture comprising variants of that neurotrophin, including eluting the neurotrophin from a hydrophobic interaction chromatography (HIC) resin with an elution buffer under conditions in which the neurotrophin separates from the variants. Support for this amendment may be found, for example, at page 3, lines 22-26 and 28-30; page 5, line 15; page 29, lines 7-25; and elsewhere in the specification and claims as originally filed.

New Claims 2-29 depend from Claim 1 and provide claims to more specific aspects and embodiments of Claim 1. These claims also find support in the specification and claims as originally filed. New Claims 2-6, for example, depend from Claim 1 and pertain to the HIC resin; these claims find support in the specification, for example, at page 11, lines 22-29; page 27, lines 24-30 to page 28, lines 1-3; page 29, lines 1-6; and elsewhere in the specification and claims as originally filed.

New Claims 7-16 depend from Claim 1 and pertain to salts in the elution buffer; these claims find support in the specification, for example, at page 29, lines 12-14 and 26-30; page 30, lines 1-5 and 16-19; and elsewhere in the specification and claims as originally filed.

New Claims 17-23 depend from Claim 1 and pertain to organic solvents in the elution buffer; these claims find support in the specification, for example, at page 11, lines 3-9; page 30, lines 6 and 11-16; and elsewhere in the specification and claims as originally filed. Claims 15 and 16 also pertain to organic solvents in the elution buffer, as discussed at page 30, lines 16-19.

New Claims 24-27 depend from Claim 1, and pertain to the pH of the elution buffer. These claims find support in the specification, for example, at page 22, lines 6-8; page 30, lines 16-18; and elsewhere in the specification and claims as originally filed.

New Claims 28 and 29 also depend from Claim 1, and specify pH buffers suitable for use in the elution buffers useful in the claimed processes. Support for Claims 28 and 29 may be found in the specification, for example, at page 10, lines 27-30; page 11, lines 1-2 and 9-12; page 30, lines 18-19; and elsewhere in the specification and claims as originally filed.

No new matter is added by way of the amendments to Claim 1 or by way of the new claims.

The title stands objected to as allegedly not descriptive.

Claim 1 is pending in the application, and stands rejected as unpatentable for statutory type "double patenting" under 35 U.S.C. §101 over U.S. Patent No. 6,423,831. Claim 1 also stands rejected as unpatentable under the judicially created doctrine of non- statutory type "double patenting" over Claims 2-22 of U.S. Patent No. 6,423,831; over Claims 1-23 of U.S. Patent No. 6,184,360; over Claims 1-25 of U.S. Patent No. 6,005,081; and as provisionally unpatentable over Claims 1-20 of co-pending U.S. Patent Application No. 10/072,681.

Claim 1 also stands rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants respectfully traverse these rejections.

**The Rejection of Claim 1 Under 35 U.S.C. §101**

Claim 1 stands rejected under 35 U.S.C. §101 as claiming the same invention as U.S. Patent No. 6,423,831. Claim 1 has been amended to be directed to a "neurotrophin" instead of the "neurotrophin homolog" of Claim 1 of U.S. Patent No. 6,423,831, and thus differs from the cited patent in at least that regard.

In addition, Claim 1 of U.S. Patent No. 6,423,831 includes steps of loading a mixture containing a neurotrophin homolog onto a HIC resin, and a step of collecting the neurotrophin homolog. Claim 1 of the present application lacks these steps. For this reason as well, Claim 1 of the present application differs from Claim 1 of U.S. Patent No. 6,423,831.

Applicants note that, in response to the question "is the same invention claimed twice?," the Federal Circuit stated "If the claimed inventions are identical in scope, the proper rejection is under 35 U.S.C. §101 because an inventor is entitled to a single patent for an invention" (*In re Goodman*, 29 USPQ2d 2010, 2015 (Fed. Cir. 1993)). Thus, where two claims differ in scope, rejection under 35 U.S.C. §101 is seen to be improper. Accordingly, since the present Claim 1 and Claim 1 of U.S. Patent No. 6,423,831 differ in scope, rejection of the present Claim 1 over Claim 1 of U.S. Patent No. 6,423,831 is improper.

Thus, the present Claim 1 differing from Claim 1 of U.S. Patent No. 6,423,831 in the elements of the claim and in the scope of the claim, Applicants respectfully submit that the rejection of Claim 1 under 35 U.S.C. §101 is overcome.

**The Rejection of Claim 1 under the Judicially-Created Doctrine of Double Patenting**

Claim 1 stands rejected under the judicially-created doctrine of double patenting as differing from Claims 2-22 of U.S. Patent No. 6,423,831 only in claim scope. However, as discussed above, Claim 1 has different elements as well as a different scope than the cited claims, and so for at least this reason is not believed to be merely an obvious variation of the same subject matter as Claims 2-22 of U.S. Patent No. 6,423,831, nor are Claims 2-22 of U.S. Patent No. 6,423,831 believed to be obvious variations of the present Claim 1.

Claim 1 also stands rejected under the judicially-created doctrine of double patenting over Claims 1-23 of U.S. Patent No. 6,184,360. However, present Claim 1 recites different elements than Claims 1-23 of U.S. Patent No. 6,184,360, and is not believed to be an obvious variant of those claims. Claims 1-23 of U.S. Patent No. 6,184,360 are also not believed to be obvious variants of present claim 1.

Claim 1 also stands rejected under the judicially-created doctrine of double patenting over Claims 1-25 of U.S. Patent No. 6,005,081. However, present Claim 1 recites different elements than Claims 1-25 of U.S. Patent No. 6,005,081, and is not

believed to be an obvious variant of those claims. Claims 1-25 of U.S. Patent No. 6,005,081 are also not believed to be obvious variants of present Claim 1.

Accordingly, Applicants believe that the rejection of Claim 1 under the judicially-created doctrine of double patenting over Claims 2-22 of U.S. Patent No. 6,423,831, Claims 1-23 of U.S. Patent No. 6,184,360, and Claims 1-25 of U.S. Patent No. 6,005,081 are overcome.

However, without acquiescing in these rejections, Applicants hereby include a Terminal Disclaimer over Claims 1-22 of U.S. Patent No. 6,423,831, Claims 1-23 of U.S. Patent No. 6,184,360, and Claims 1-25 of U.S. Patent No. 6,005,081 so that a U.S. Patent issued with the present claims from the present application will have a patent term no longer than the full patent term of U.S. Patent No. 6,423,831, of U.S. Patent No. 6,184,360, and of U.S. Patent No. 6,005,081.

**The Provisional Rejection of Claim 1 under the Judicially-Created Doctrine of Double Patenting**

Claim 1 stands provisionally rejected under the judicially-created doctrine of double patenting as claiming the same subject matter as Claims 1-20 of co-pending U.S. Patent Application 10/072,681. However, among other differences, Claims 1-20 of co-pending U.S. Patent Application No. 10/072,681 is directed to a neurotrophin homolog, and not a neurotophin as in the present Claim 1. The present Claim 1 has different elements, and is not believed to be an obvious variant of Claims 1-20 of co-pending U.S. Patent Application No. 10/072,681, nor are Claims 1-20 of co-pending U.S. Patent Application No. 10/072,681 believed to be obvious variants of present Claim 1.

Accordingly, Applicants believe that the rejection of Claim 1 under the judicially-created doctrine of double patenting over Claims 1-20 of U.S. Patent Application No. 10/072,681 is overcome.

However, without acquiescing in these rejections, Applicants hereby include a Terminal Disclaimer over Claims 1-20 of U.S. Patent Application No. 10/072,681 so that a U.S. Patent issued with the present claims from the present application will have a patent term no longer than the full patent term of a patent issued to U.S. Patent

Application No. 10/072,681 having claims substantially as presently pending in that application.

**The Rejection of Claim 1 Under 35 U.S.C. §112, Second Paragraph**

Claim 1 stands rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, the Examiner objecting to the phrase "containing onto." Applicants note that, as amended, Claim 1 no longer contains the phrase "containing onto" and so believes the rejection to be moot.

Accordingly, Applicants believe that the rejection of Claim 1 under 35 U.S.C. §112, second paragraph, is overcome.

**CONCLUSION**

For the reasons set forth above, Applicants believe that all claims are in condition for allowance. The Examiner is respectfully requested to reconsider the rejection of Claim 1 and to consider new Claims 2-29, and to allow all pending claims. Should the Examiner believe that a telephone interview would expedite the prosecution of this application, Applicants invite the Examiner to call the undersigned attorney at the telephone number indicated below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. **08-1641** referencing Attorney's Docket No. **39766-0037 C3C1**.

Respectfully submitted,

Dated: September 15, 2004

By: _____
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